

REMARKS

Claims 1-72 are pending in the application.

Claims 1-68 stand rejected.

Claims 42, 62, 65, and 67 have been amended. Support for the amendments to claims 62, 65, and 67 can be found, at least, on page 8, line 8 - page 9, line 24.

Claims 69-72 have been added. Support for these claims can be found, at least, on lines 25-33 of page 15.

Rejection of Claims under 35 U.S.C. §112

Claim 42 stands rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Claim 42 has been amended so that claim 42 no longer recites a single means. Support for this amendment can be found, at least, on page 11, line 12 - page 11, line 11 of the specification.

Statutory Double Patenting Rejection

Claims 1-66 are provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1-66 of copending Application No. 09/572,199. Applicants respectfully traverse this rejection.

Claim 1 of the present application recites “establishing a Call Optimization Application (COA) channel between a Multipoint Controller-Call Optimization Application (MC-COA) and a Call Optimization Application co-resident with the first terminal (Terminal-COA), said establishing a COA channel effected via instant messaging following an address resolution” (emphasis added). In contrast, claim 1 of Application No. 09/572,199 is silent with respect to the protocol used to effect establishment of a COA channel. Thus, claim 1 of Application No. 09/572,199 could be infringed by effecting establishment of a COA channel by a non-instant messaging protocol such as Internet Protocol. This shows that claim 1 of Application No. 09/572,199 can be infringed without infringing claim 1 of the present application.

Accordingly, the two claims do not describe identical subject matter. See MPEP §804(II)(A) (“If there is [an embodiment of the invention that falls within the scope of one claim, but not the other], then identical subject matter is not defined by the claims and statutory double patenting would not exist.” p. 800-20). Claims 2-66 similarly define different subject matter than the claims of copending Application No. 09/572,199. Accordingly, withdrawal of the statutory double patenting rejection is requested.

Obviousness-Type Double Patenting Rejection

Claims 1-8, 11, 12, 20, 22-29, 40, 41, and 62-68 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 12-18, 29, and 30 of U.S. Patent No. 6,694,351. U.S. Pat. No. 6,694,351 is assigned to Cisco Technology, Inc., as recorded at Reel 010917, Frame 0099. Likewise, the present application has also been assigned to Cisco Technology, Inc., as recorded at Reel 011708, Frame 0575. Since the conflicting patent is commonly owned with the present application, a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) can be used to overcome the double-patenting rejection. See 37 CFR 1.130(b). A terminal disclaimer has been submitted along with this response. As such, Applicants assert that the double-patenting rejection is now moot and withdrawal of this rejection is respectfully requested.

Added Claims

Added claims 69-72, which respectively depend from claims 10, 30, 46, and 55, are patentable for at least the foregoing reasons provided above.

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5087.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 19, 2004.

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Date of Signature

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